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EXAMINER

JANVIER, JEAN D

ART UNIT

PAPER NUMBER

3622

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/375,005

Applicant(s)

SUGAHARA, YASUO

Examiner

Jean D Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Response To Applicant's Amendments

Newly submitted claim 29 is directed to an invention that is independent or distinct from the invention originally claimed (see lines 13-21 of the claim).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 29 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Arguments

The Examiner approves the changes made by the Applicant in order to further clarify the claimed invention. However, the changes are not sufficient to overcome the art rejection since the changes or amendments merely replace one claim language with a similar claim language having the same or similar scope. For example, claim 9 recites the limitations “a target customer finder finds target customers who purchased a product suitable to be replaced that has a lower performance level than a promoting product”, which are being replaced with “a target customer finder that searches for customer based on their having purchased a product suitable to be replaced and also based on the product suitable to be replaced having a lower performance level than the promoting”. One of ordinary skill in the art would have concluded that the amended claims are mere copies of the original claims as presented in the last office action. Therefore, the same art rejection will be applied to the amended claims. Finally, it is important, as mentioned in the last office action, that Applicant provide support for any amended claim or new claim, that is page or column numbers and line numbers in the specification, thereby expediting prosecution of

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the case. Nevertheless, Applicant has failed to do so. Finally, although the Examiner will not raise any 112(1) at this time, it appears that there is no clear support for “interactively inputting ...” and “...in response to interactively inputting information identifying the promoted product”.

Regarding the 103 rejection, the information (public disclosure) provided by the Examiner has been in the public domain or available in the industry for many years and practiced by small entrepreneurs or small businesses, such Compunet, DSI computer service and/or Bitsoft Computer Service all registered in New York and conducting business in New York City, especially Ca.1995. These small businesses are no longer trading. The Examiner of record happens to be the owner of Bitsoft Computer Service, which stopped trading in November 2,000 when the Patent Office hired the Examiner. Therefore, the Examiner is well positioned or qualified to disclose business strategies practiced or used by professionals in the art in the 1990's. It is rather inconceivable that the Applicant is not aware of those business strategies. Further, because a written document is not available does not necessarily imply that the claimed invention is patentable. In addition, the Examiner will not provide any written document to support the public disclosure presented in the office action, especially when those business strategies or methods have been used or practiced in the industry for many years well before the filing date of the Instant Application. Moreover, Applicant's request for a written document fails to point out specific deficiencies in the Examiner's public disclosure (“Official Notice”). Finally, Application should be aware of well-known aspects of the subject matter for which the Applicant is seeking a patent.

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Furthermore, concerning the 102 rejection, Applicant argues that, to the extent, that Deaton extracts customer information, it is based on the customer's identity received from the POS, not on the customer having previously purchased a product suitable to be replaced by a promotion product. Applicant also points out that Deaton cannot teach using a promotion product to search for multiple customers and then promote a product to the multiple customers. The Examiner respectfully and completely disagrees with the Applicant's findings. Indeed, Deaton discloses, in one or more embodiments as shown in figs. 15A-B, a system for building a customer database and a related mailing list by gathering information about customers from checks from a variety of different banks, wherein checking account numbers are entered into a processor 110, having a database, and subsequently used as IDs to identify customers. The database, containing customers' records including customers' names and addresses, checking account numbers, customers' shopping habits and transactional data over pre-selected time interval, is coupled to processor 110. It is understood that before interactively inputting a customer's data, such as the customer's checking account number or customer's ID, into the database, processor 110 searches the said database in order to detect if the customer is a participating customer. To this end, a response is generated by processor 110 to signal the presence of the customer's checking account number or the failure to find or locate such checking account number in the database. If the customer's checking account number or ID does not exist in the database, then a new record is created for that customer using his ID or checking account number so that the customer's profile (name and address) and his shopping history can be interactively inputted into the record stored in the database. Subsequently a list or mailing list of customers is generated in the database whose last transaction date is prior to a pre-selected

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interval of inactivity so that grouping or sub-grouping (category or subcategory) of customers (infrequent shoppers) selected to receive one or more promotional offers or one or more promotion products, based on the selected customers' prior shopping histories, is available. For instance, a promotional offer such as a coupon is associated with a promotional product, suitable to replace a competitor's brand or an existing product, can be mailed to one or more infrequent customers from the list based, for example, on a threshold dollar amount spent during a pre-determined period of time (col. 64: 20-59; col. 63: 32-41; col. 62: 23-28; col. 62: 51-55; col. 71: 46-67). In addition, promotions can be directed to customers' attentions based upon items that the customers have historically purchased (col. 90: 36-50; col. 98: 20-40). In summary, promotions are mailed to selected customers from a generated mailing list stored in the database coupled to processor 110 in accordance with the customers' profiles (names and addresses) and shopping histories (col. 7: 35-36). Further, contrary to the Applicant's findings, one or more promotions are offered to selected customers based upon more than one criterion. In fact, one or more promotions may be directed to a group of selected customers (infrequent shoppers) based on the degree of absenteeism and the shopping price range (a combination of infrequent visits and shopping price range) (col. 71: 4-9).

Finally, although "5,649,114" is a jumbo patent, however, it is the Applicant's responsibility to review the entire reference vis-à-vis the claimed invention. The Examiner, in prosecuting the claims on the merits, makes references to some specific column and line numbers based upon what is understood from the claimed invention. Nevertheless, other appropriate portions of the reference may also be used in examining the claimed invention.

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Therefore, Applicants' argument, as described herein, is not plausible and the Applicants' request for allowance has been respectfully denied. The previous office action rejection is maintained and the present action, as submitted below, **has been made final**.

DETAILED ACTION

Specification

Status of the claims

Claim 1-28 are still pending in the Instant Application and newly added claim 29 is withdrawn from consideration.

Claim Objections

Claims 1 (and its dependent claims) and 22-24 are objected to because of the following informalities:

Concerning claim 1, lines 4-5, it not clear how a plurality of "previously purchased products" can be replaced with a single "promotion product".

Concerning claim 22, line 6, it appears that "the finding in response to interactively identifying the promoting commodity" is inconsistent with the rest of the claim.

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Concerning claim 23, lines 3-4, it appears that “, the finding in response to interactively identifying the promoting commodity” is inconsistent with the rest of the claim.

Concerning claim 24, lines 5-6, it appears that “, the finding in response to interactively identifying the promoting commodity” is inconsistent with the rest of the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 16-20, 22 and 24 are rejected under 35 U.S.C. 102 (b) for being anticipated by Deaton et Al, U.S Patent 5,649,114, July 15, 1997.

As per claim 1, Deaton et al teach a system for providing selective incentives to a customer or “transactor” if and only if the customer’s or “transactor’s” shopping history or transaction history or purchase history meets some predetermined criteria, such as demographics,

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recency, frequency, volume purchase data, timing of purchases or purchase cycle data, brand loyalty, coupon redemption data and custom price sensitivity data and infrequent purchase data, as set forth by a retailer. Upon analyzing the shopping history data or purchase history data using a program subroutine as disclosed in figs. 18 and 23-47 or any conventional data mining technique, a decision is made, subsequent to determining the customer's purchase habits or pattern or tendencies, on whether or not the said customer should receive a selective incentive and/or be targeted for a particular product promotion. **See Col. 1: 66 to Col. 2: 4; Col. 65: 61 to Col. 67: steps 40-46; Col. 68: 8-16; Col. 71: 4 to Col. 72: 58.** Subsequent to analyzing the customer's purchase habits or transaction tendencies, determining or predicting the customer's tendency to purchase a particular product and upon finding this product that the customer will soon buy or replace next on a given due date, providing a coupon to the customer redeemable on this particular product (col. 71: 31 to col. 72: 58). Further, it is to be understood that specification of the promoted product, such as a coffee brand, will be analyzed and compared to the specification of coffee brands previously purchased by the particular to thereby determine if the particular user or customer is a good prospect or candidate for the new promotion or new coffee brand, as inherently disclosed in the art. Finally, the step of selecting product introductions or product promotions to target the particular customer based on his prior transaction tendencies by issuing a coupon corresponding to a product promotion to the particular so as to encourage the customer to purchase the promoted product in an effort to patronize a new product is implicitly disclosed or inherent in the current reference (col. 71: 31-67).

See col. 65: 20-24; col. 90: 36-50; col. 93: steps 267-272; col. 100: 64 to col. 101: 13; col. 101: 48 to col. 103: 45.

As per claims 2 and 8, Deaton et al disclose a system for deciding on at least one customer's transaction habits or tendencies, **such as product loyalty or brand loyalty or product preference**, associated with at least one product type **such as coffee** listed in his/her purchase history data and subsequently providing to said customer an incentive or coupon, redeemable for a preferred product or a product used during a future transaction with a store (Col. 71: 31-45).

As per claims 3 and 7, Deaton et al disclose a system for detecting from a customer's transaction history a customer's transaction habits associated with a product type such as coffee (Col. 71: 31-45) and subsequent to detecting, providing an incentive or coupon to the said customer to buy a related or **new** product such as a coffee filter (Col.71: 46-67) and upon scanning a product at the POS in a future transaction with a store, determining that at least one of the products purchased is indeed the coffee filter and if so applying the discount and finally storing the redemption data in a BCTT table in a database associated with CVC Master Controller of fig.19 (fig. 22; Col. 77: step 1 to Col. 78: 10).

Claim 4 substantially recites the limitations of claim 2 and therefore, these limitations of claim 4 are rejected under a similar rationale. Claim 4 further recites **a product rank instead of a product type**. As per this feature, Deaton et al disclose a system for providing a selective incentive to a customer based on his transaction history. From the customer's transaction history data, transaction habits or tendencies, such as product preference, product heavily used (high

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ranking), product loyalty or brand loyalty or product infrequently used (low ranking) can be determined so that the customer can further be targeted (Col. 71: 31-67).

Claim 5 substantially recites the limitations of claim 3 and therefore, these limitations of claim 5 are rejected under a similar rationale. Claim 5 further recites **a product rank instead of a product type**. As per this feature, Deaton et al disclose a system for providing a selective incentive to a customer based on his transaction history. From the customer's transaction history data, transaction habits or tendencies, such as product preference, product heavily used (high ranking), product loyalty or brand loyalty or product infrequently used (low ranking) can be determined so that the customer can further be targeted (Col. 71: 31-67).

As per claim 6, Deaton et al disclose a system for deciding on at least one or more customer's transaction habits or tendencies, **such as product loyalty or brand loyalty, product preference or product frequency purchase**, associated with at least one product type **such as coffee** listed in his/her purchase history data and subsequently providing to said customer an incentive or coupon, redeemable for a preferred product or a product used during a future transaction with a store (Col. 71: 31-45). Deaton et al further disclose a system for providing a selective incentive to a customer based on his transaction history. From the customer's transaction history data, transaction habits or tendencies, such as product preference, product heavily used (high ranking), product loyalty or brand loyalty or product infrequently used (low ranking), can be determined so that the customer can further be targeted (Col. 71: 31-67).

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Claim 16 substantially recites the limitations of claim 1 and therefore, these limitations of claim 16 are rejected under a similar rationale. Claim 16 further recites a computer program product encoded on computer readable medium enabled, when executed on a computer or processor, to perform the steps of the claimed invention as disclosed herein. As per these features, Deaton et al disclose in figs.18 and 19-45 a computer program product or program subroutine encoded on a storage medium enabled, when executed on CVC Master Controller 965, to perform the tasks described above.

Claim 17 substantially recites the limitations of claim 2 and therefore, these limitations of claim 17 are rejected under a similar rationale. Claim 17 further recites a computer program product encoded on computer readable medium enabled, when executed on a computer or processor, to perform the steps of the claimed invention as disclosed herein. As per these features, Deaton et al disclose in figs.18 and 19-45 a computer program product or program subroutine encoded on a storage medium enabled, when executed on CVC Master Controller 965, to perform the tasks described above.

Claim 18 substantially recites the limitations of claim 2 and therefore, these limitations of claim 18 are rejected under a similar rationale. Claim 18 further recites a computer program product encoded on computer readable medium enabled, when executed on a computer or processor, to perform the steps of the claimed invention as disclosed herein. As per these features, Deaton et al disclose in figs.18 and 19-45 a computer program product or program

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subroutine encoded on a storage medium enabled, when executed on CVC Master Controller 965, to perform the tasks described above.

Claim 19 substantially recites the limitations of claim 7 and therefore, these limitations of claim 19 are rejected under a similar rationale.

Claim 20 substantially recites the limitations of claim 8 and therefore, these limitations of claim 20 are rejected under a similar rationale.

Claims 22 and 24 substantially recite limitations already addressed in claim 1 and therefore, these limitations of claims 22 and 24 are rejected under a similar rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-15, 21, 23 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deaton et al. (hereinafter Deaton), US Patent 5,649,114. .

As per claim 9, Deaton et al teach, among other things a system for targeting customers based on factors such as demographics, recency, frequency, volume purchase data, timing of purchases or purchase cycle data, brand loyalty, coupon, redemption data and custom price sensitivity. These factors are used to develop coupon lists, associated with customers' transaction habits or tendencies, which are spooled to a coupon printer for delivery to the customers at the checkout register. Alternatively, the coupon lists may be spooled to an electronic medium, such as customers' smart cards, or a store's system controller mass storage device for automatic electronic redemption on a future bill (figs. 19-45).

Furthermore, Deaton et al teach a system for providing selective incentives to a customer or "transactor" if and only if the customer's or "transactor's" shopping history or transaction history or purchase history meets some predetermined criteria, such as demographics, recency, frequency, volume purchase data, timing of purchases or purchase cycle data, brand loyalty, coupon redemption data and custom price sensitivity data and infrequent purchase data, as set forth by a retailer. Upon analyzing the shopping history data or purchase history data using a program subroutine as disclosed in figs. 18 and 23-47 or any conventional data mining technique, a decision is made, subsequent to determining the customer's purchase habits or pattern or tendencies, on whether or not the said customer should receive a selective incentive and/or be targeted for a particular product promotion.

See Col. 1: 66 to Col. 2: 4; Col. 65: 61 to Col. 67: steps 40-46; Col. 68: 8-16; Col. 71: 4 to Col. 72: 58.

Finally, Deaton teaches a system wherein a customers' purchase history, such as price sensitive data, volume purchase data, frequency of shopping data, brand loyalty data and so on,

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is used not only to target the customers by offering different categories of discount coupons (coupon A, coupon M, standard coupon, echo coupon etc) redeemable on particular promotional products to the said customers, but also to anticipate or predict what the customers will purchase next and prepare a specific promotional package to target these particular customers (col. 71: 30-45 and steps 200-211; col. 100: 64 to col. 101: 13; col. 101: 48 to col. 103). Deaton, for example, clearly points out that transaction tendencies or patterns can be used to at least divide customers into two groups, that is customers who are price sensitive and those who are not. Based on this grouping, two different promotional messages regarding a particular promoted product will be generated. The customer who is price sensitive will receive a coupon with a higher value to encourage him to buy the promoted product while the other customer will receive a coupon with a lower value to buy the promoted product, as depicted in col. 93: step 272.

Although Deaton implicitly or explicitly discloses all the limitations of the claim, he does not expressly teach a method and/or system for categorizing a customer's transaction tendency or trend or habit by purchasing speed and system type purchasing read from the customer's past transaction data.

However, using a customer's past shopping transaction stored in a dealer's or retailer's database or information provided to a system manufacturer or distributor by the customer on a product or computer system registration form, a retailer or more specifically a computer distributor or manufacturer can target a specific customer based on his purchasing tendencies or transaction tendencies or habits, extracted from the retailer's database or system registration form, including, but not limited to, system speed (high-end, low-end or entry level, standard or

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mid-range), system type (brand's name, OEM or IBM compatible or clones or custom-built or built- to- order system), notebook or laptop, desktop (desktop case or tower case or housing), and so on. For example, many small entrepreneurs, involved in the sales of custom-built PCs, encourage their customers to trade in their old systems in an effort to boost new system sales, wherein the dollar values associated with the trade ins are used to discount or reduce the price of new systems, regardless of the source of the old or legacy systems. Subsequently, the old systems can be sold by the small entrepreneurs, as it or after an upgrade, to other customers in the USA or abroad, especially in Third World countries, in need for systems at discounted prices. Further, the old or legacy systems can be donated, as it or after an upgrade, to non-profit organizations by the small entrepreneurs, wherein the entrepreneurs can use the dollar values related to the donations of the old systems to reduce their business income tax. In the event the old or legacy systems (low performers) are not sold, they can be taken apart or salvaged and the various components can be used by the small entrepreneurs to conduct hands-on activities in PC Tech classes. PC Tech students sometimes have to buy these old components from third parties in order to practice the skills taught in training classes. Moreover, there are companies in the USA that are involved in the recycling of unwanted old computers by removing the silicon chips and other important chips useful in other electronic circuits, thereby preventing individual customers or corporations from dumping these old computers in the open field, which can create an environmental problem or crisis. Finally, Gateway 2000, a computer manufacturer, upon selling a new computer system to a customer promises or advertises that the customer can trade in this new system (later on low performer) in two years for a brand new and more powerful computer system using the dollar figure associated with the trade in to reduce the price of the

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new powerful system, thereby converting a one time customer into a loyal customer by maintaining a business relationship with the said customer while bringing him/her back to a Gateway Country store or Gateway website to complete the trade in and hence receive the new and more powerful computer system, subsequent to paying a balance due, as promised.

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the above disclosure into Deaton's customized incentive system so as to include a computer system as a product or commodity sold at a participating retailer and record in a database, in a manner similar to recording other transaction data, the customer's transaction involving the purchase of computer systems, wherein data related to system speed (high-end, low-end or entry level, standard or mid-range), system type (brand's name, OEM or IBM compatible or clones or custom-built or built- to- order system), notebook or laptop, desktop (desktop case or tower case or housing) and date of purchase are recorded or stored in the database and used to further target the said customer by providing the customer with a discount coupon on a new computer system, based on the speed, type and purchase date of previously purchased computer systems, in an effort to boost sales of new computer systems while maintaining a good relationship with the customer by bringing him/her back to a participating retailer's store to redeem the coupon upon purchasing the new system, thereby preventing the customer from buying a similar or comparable system from a competitor while encouraging him/her to patronize a participating store since the customer can only redeem the discount coupon at a participating or specific POS upon purchasing the brand new and more powerful system.

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As per claim 10, Deaton et al teach a system for providing selective incentives to a customer or “transactor” if and only if the customer’s or “transactor’s” shopping history or transaction history or purchase history meets some predetermined criteria, such as demographics, recency, frequency, volume purchase data, timing of purchases or purchase cycle data, brand loyalty, coupon redemption data and custom price sensitivity data and infrequent purchase data, as set forth by a retailer. Upon analyzing the shopping history data or purchase history data using a program subroutine as disclosed in figs. 18 and 23-47 or any conventional data mining technique, a decision is made, subsequent to determining the customer’s purchase habits or pattern or tendencies, on whether or not the said customer should receive a selective incentive and/or be targeted for a particular product promotion. **See Col. 1: 66 to Col: 2: 4; Col. 65: 61 to Col. 67: steps 40-46; Col. 68: 8-16; Col: 71: 4 to Col.72: 58.** Subsequent to analyzing the customer’s purchase habits or transaction tendencies, determining or predicting the customer’s tendency to purchase a particular product and upon finding this product that the customer will soon buy or replace next on a given due date, providing a coupon to the customer redeemable on this particular product (col. 71: 31 to col. 72: 58). Further, it is to be understood that specification of the promoted product, such as a coffee brand, will be analyzed and compared to the specification of coffee brands previously purchased by the particular to thereby determine if the particular user or customer is a good prospect or candidate for the new promotion or new coffee brand, as inherently disclosed in the art. Finally, the step of selecting product introductions or product promotions to target the particular customer based on his prior transaction tendencies by issuing a coupon corresponding to a product promotion to the particular so as to encourage the

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customer to purchase the promoted product in an effort to patronize a new product is implicitly disclosed or inherent in the current reference (col. 71: 31-67).

See col. 65: 20-24; col. 90: 36-50; col. 93: steps 267-272; col. 100: 64 to col. 101: 13; col. 101: 48 to col. 103: 45.

Although Deaton implicitly or explicitly discloses all the limitations of the claim, he does not expressly teach a method and/or system for offering a promoted replacement computer system to a customer using the customer's past purchase transaction data related to the purchase of computer systems, which show the customer's tendency or preference for computer systems having a certain speed or type.

However, using a customer's past shopping transaction stored in a dealer's or retailer's database or information provided to a system manufacturer or distributor by the customer on a product or computer system registration form, a retailer or more specifically a computer distributor or manufacturer can target a specific customer based on his purchasing tendencies or transaction tendencies or habits, extracted from the retailer's database or system registration form, including, but not limited to, system speed (high-end, low-end or entry level, standard or mid-range), system type (brand's name, OEM or IBM compatible or clones or custom-built or built- to- order system), notebook or laptop, desktop (desktop case or tower case or housing), and so on. For example, many small entrepreneurs, involved in the sales of custom-built PCs, encourage their customers to trade in their old systems in an effort to boost new system sales, wherein the dollar values associated with the trade ins are used to discount or reduce the price of new systems, regardless of the source of the old or legacy systems. Subsequently, the old

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systems can be sold by the small entrepreneurs, as it or after an upgrade, to other customers in the USA or abroad, especially in Third World countries, in need for systems at discounted prices. Further, the old or legacy systems can be donated, as it or after an upgrade, to non-profit organizations by the small entrepreneurs, wherein the entrepreneurs can use the dollar values related to the donations of the old systems to reduce their business income tax. In the event the old or legacy systems (low performers) are not sold, they can be taken apart or salvaged and the various components can be used by the small entrepreneurs to conduct hands-on activities in PC Tech classes. PC Tech students sometimes have to buy these old components from third parties in order to practice the skills taught in training classes. Moreover, there are companies in the USA that are involved in the recycling of unwanted old computers by removing the silicon chips and other important chips useful in other electronic circuits, thereby preventing individual customers or corporations from dumping these old computers in the open field, which can create an environmental problem or crisis. Finally, Gateway 2000, a computer manufacturer, upon selling a new computer system to a customer promises or advertises that the customer can trade in this new system (later on low performer) in two years for a brand new and more powerful computer system using the dollar figure associated with the trade in to reduce the price of the new powerful system, thereby converting a one time customer into a loyal customer by maintaining a business relationship with the said customer while bringing him/her back to a Gateway Country store or Gateway website to complete the trade in and hence receive the new and more powerful computer system, subsequent to paying a balance due, as promised.

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the above disclosure into Deaton's customized incentive system so as to

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include a computer system as a product or commodity sold at a participating retailer and record in a database, in a manner similar to recording other transaction data, the customer's transaction involving the purchase of computer systems, wherein data related to system speed (high-end, low-end or entry level, standard or mid-range), system type (brand's name, OEM or IBM compatible or clones or custom-built or built- to- order system), notebook or laptop, desktop (desktop case or tower case or housing) and date of purchase are recorded or stored in the database and used to further target the said customer by providing the customer with a discount coupon on a new computer system, based on the speed, type and purchase date of previously purchased computer systems, in an effort to boost sales of new computer systems while maintaining a good relationship with the customer by bringing him/her back to a participating retailer's store to redeem the coupon upon purchasing the new system, thereby preventing the customer from buying a similar or comparable system from a competitor while encouraging him/her to patronize a participating store since the customer can only redeem the discount coupon at a participating or specific POS upon purchasing the brand new and more powerful system.

Claims 15, 23, 25 and 27 substantially recite the limitations of claim 9 and therefore, these limitations of claim 15, 23, 25 and 27 are rejected under a similar rationale as applied to claim 9.

Claims 26 and 28 substantially recite the limitations of claim 10 and therefore, these limitations of claims 26 and 28 are rejected under a similar rationale as applied to claim 10.

Claim 21 substantially recites the limitations of claim 9 and therefore, these limitations of claim 21 are rejected under a similar rationale. Claim 21 further recites a computer program product encoded on computer readable medium enabled, when executed on a computer or processor, to perform the steps of the claimed invention as disclosed herein. As per these features, Deaton et al disclose in figs.18 and 19-45 a computer program product or program subroutine encoded on a storage medium enabled, when executed on CVC Master Controller 965, to perform the tasks described above.

As per claims 11-12 and 14, Deaton et al disclose a system for deciding on at least one customer's transaction habits or tendencies, **such as product loyalty or brand loyalty or product preference**, associated with at least one product type **such as coffee** listed in his/her purchase history data and subsequently providing to said customer an incentive or coupon, redeemable for a preferred product or a product used during a future transaction with a store (Col. 71: 31-45). Further, Deaton et al disclose a system for providing a selective incentive to a customer based on his transaction history. From the customer's transaction history data, transaction habits or tendencies, such as product preference, product heavily used (high ranking), product loyalty or brand loyalty or product infrequently used (low ranking) can be determined so that the customer can further be targeted (Col. 71: 31-67).

As per claim 13, Deaton et al disclose a system for detecting from a customer's transaction history a customer's transaction habits associated with a product type such as coffee

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(Col. 71: 31-45) and subsequent to detecting, providing an incentive or coupon to the said customer to buy a related or **new** product such as a coffee filter (Col.71: 46-67) and upon scanning a product at the POS in a future transaction with a store, determining that at least one of the products purchased is indeed the coffee filter and if so applying the discount and finally storing the redemption data in a BCTT table in a database associated with CVC Master Controller of fig.19 (fig. 22; Col. 77: step 1 to Col. 78: 10).

Conclusion

Although the following references were not used in the Office Action, they were highly considered by the Examiner. Applicants are further directed to consult these references.

US Patent 6, 026,370-This reference constitutes a relevant prior art under 102(e).

Japanese Patents- 06119309 A and 06068065 A.

Japanese Patent 09237265A can be used in a 102 and/or 103 rejection of the claimed invention.

US Patent 5,974,396A to Anderson et al discloses a system for gathering and analyzing consumer purchasing information based on product and consumer clustering relationships.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113. Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final- 703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240

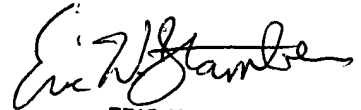
Customer Service- 703-872-9325

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Please provide support, that is page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.

JDJ

05/08/03


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